

JUL 18 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Brosnan

Application No.: 09/595,798

Filed: June 16, 2000

Title: USING A GAMING MACHINE AS A SERVER

Attorney Docket No IGT1P021/P-239

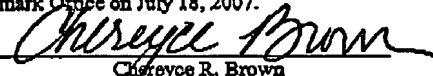
Examiner: William H. McCulloch, Jr.

Group: 3714

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to fax number 571-273-8300 of the U.S. Patent and Trademark Office on July 18, 2007.

Signed:


Chereyoe R. Brown

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22314

Dear Sir:

Applicants hereby request review of the final rejections in the above-identified application. Review is requested for the reasons stated in the accompanying five-page Remarks Section.

This Request is being filed with a Notice of Appeal.

No amendments are being filed with this Request.

REMARKS

The examiner rejected claims 27-28, 38-42, 45-53 and 55-56 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yoseloff (6,913,531).

The examiner rejected claims 43 ad 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Yoseloff (6,913,531) in view of Kelly (6,306,035).

Applicant believes the rejection under 35 USC 102(e) is improper because Yoseloff fails to teach all the limitations of the pending claims. For example, claim 27 recites, a method for providing game downloading in a gaming system, the method comprising, providing a first gaming machine comprising ... ii) a first master gaming controller coupled to the housing designed or configured to control a first game selected from a list of games displayed on the first gaming machine; iii) one or more displays coupled to the first housing for displaying the first game controlled by the first master gaming controller or the list of games; providing the second gaming machine comprising i) a second housing; ii) a second master gaming controller coupled to the housing designed or configured to control a second game played on the second gaming machine ... vi) a second memory storing executable coding instructions for the first gamedisplaying the list of games on the first gaming machine wherein a play of at least the first game in the list of games is only enabled after a download of the executable coding instructions for the first game from the second gaming machine and wherein the executable coding instructions allow the first master gaming controller to determine a first outcome for the first game in response to inputs made at the first gaming machine by a player including a wager on the first outcome;"

Examiner states, "*Yoseloff teaches that a second gaming machine is substantially the same or exactly the same as the first device 11:44-46. The second in one embodiment is described as a "peer" device in 11:43.*" An examination of claim 27 and pending claims indicates that the first gaming machine and the second gaming machine are not substantially the same or exactly the same from the point of view of the recited limitations. Thus, Yoseloff can't be said to teach or suggest the method cited in the pending claims. For instance, the first master gaming controller on the first gaming machine is designed or configured to control a first game selected from a list of games displayed on the first gaming machine where a play of at least the first game in the list of games is only enabled after a download of the executable coding

instructions for the first game from the second gaming machine. Similar limitations are not recited for the second gaming machine.

Further, the second gaming machine is designed or configured to control a second game played on the second gaming machine and comprises a second memory storing executable instructions for the first game. Claim 27 doesn't recite a limitation in regards to whether the first gaming machine is designed or configured to control the second game or comprises a memory for storing executable coding instructions for the second game. Examiner has failed to indicate in Yoseloff a first gaming machine and a second gaming machine with the respective limitations cited with respect to claim 27 or 46 and by Examiner's admission Yoseloff doesn't teach first and second gaming machines as recited in the pending claims because Examiner states that Yoseloff teaches the second gaming machine is exactly or substantially the same as the first gaming device.

In addition, Applicant believes the Examiner has reached erroneous conclusions in regards to the teachings of Yoseloff. For example, claim 27 recites, "a first output device coupled to the first housing for outputting the cash or the indicia of credit;" and "a second output device coupled to the second housing for outputting the cash or the indicia of credit wherein the second gaming machine is operable to output an award associated with the outcome as the cash or the indicia of credit." Examiner says these limitations are equivalent to a "payout indicated in payout window, see at least 13:56-59; see also 7:57-61 and 8:10-20." These citations from Yoseloff merely describe rules for a game, i.e., in a particular situation an award of such and such is to be made. The citations don't, however, describe, for example, a device that actually outputs a tangible media, such as cash or an indicia of credit. Applicant notes that in FIG. 1 and its associated description, such a device is clearly not shown or suggested.

In another example, Applicant believes the Examiner has reached erroneous conclusions regards to the teachings of Yoseloff with respect to limitations including "a list of games," such as 1) "a first master gaming controller coupled to the housing designed or configured to control a first game selected from a list of games displayed on the first gaming machine," 2) "one or more displays coupled to the first housing for displaying the list of games and the first presentation of the first outcome," 3) "displaying the list of games on the first gaming machine wherein a play of at least the first game in the list of games is only enabled after a download of the executable coding instructions for the first game from the second gaming machine" or 4)

"receiving a game selection signal for the first game in the list of games displayed on the first gaming machine," as recited in claim 27.

Examiner states,

Yoseloff teaches that gaming devices may obtain the program modules by downloading them from a network, such as the Internet, in 11:5-17. Yoseloff teaches that downloading may be associated with a manual operation performed by a human operator (see at least 9:51-59). The recitation of "downloading" one or more program module is selected for transfer by a user, at which point a signal indicating the selection is sent to a second gaming device to begin the information transfer. Yoseloff does not use the term "list" of programs, but allows for multiple program modules to be downloaded under the control of the player. Therefore a list of program modules is inherently present in Yoseloff's system in order to allow the user of Yoseloff's gaming device to select a program module for download.

First, Applicant notes, Examiner ignores the claim language in their rejection. The claims recite "a list of games" not a "list of programs." Thus, Examiner never points out where the four limitations above that include "list of games" are taught or suggested in Yoseloff.

Further, Applicant doesn't see how one would conclude that Yoseloff teaches or suggests a list of games. In 11:5-17, Yoseloff describes "a network browsing module is also a tool capable of using downloadable program modules, such as the puzzle control modules, in order to direct operations of the personal computer." In this recitation, Yoseloff is simply indicating that a network browser, such as Internet Explorer, can use downloadable program modules. Further, Yoseloff's invention is the rules for a game and Yoseloff's description focuses on that game. For instance, in 12:47-52, Yoseloff recites, "the following description, in conjunction with a view of FIG. 1, will be provided as a detailed description of the play of a single hand of the game of the invention, executed on a video gaming apparatus with hardware and software enabling the game (Emphasis added by Applicant.)"

Thus, since Yoseloff focus is on the rules to a particular game and Yoseloff makes no mention of a list of games, Applicant believes Yoseloff can't be said to teach or suggest any of the following four limitations, 1) "a first master gaming controller coupled to the housing designed or configured to control a first game selected from a list of games displayed on the first gaming machine," 2) "one or more displays coupled to the first housing for displaying the list of games and the first

presentation of the first outcome," 3) "displaying the list of games on the first gaming machine wherein a play of at least the first game in the list of games is only enabled after a download of the executable coding instructions for the first game from the second gaming machine" or 4) "receiving a game selection signal for the first game in the list of games displayed on the first gaming machine."

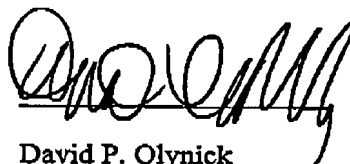
Therefore, for at least the reasons above, Applicant believes the rejection under 102(e) is improper and the rejection should be withdrawn.

Examiner relies on Kelly to teach jurisdictional requirements. The combination of Yoseloff and Kelly doesn't overcome the deficiencies recited with respect to the 102(e) rejection. In view of the foregoing, it is respectfully submitted that the rejections of all pending claims should be withdrawn.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a Notification of Allowance to that effect. If any fees are due in connection with this Response to Office Action or for this application in general then the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0388, referencing Docket No. IGT1P021. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number below with any questions or concerns relating to this document or application.

Respectfully Submitted,
BEYER WEAVER LLP



David P. Olynick
Reg. No.: 48,615

Beyer, Weaver & Thomas LLP
P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100